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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,577	06/09/2000	Charles A. Eldering	T702-03	2970

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EXPANSE NETWORKS, INC.
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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/591,577

Applicant(s)
Charles ELDERING et al.

Examiner
Stephen M. Gravini

Art Unit
3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-17-01
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-75 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 & 7 6) ☐ Other:

Art Unit: 3622

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the abstract exceeds the length prescribed by 37 CFR 1.72. Rule 72 allows an abstract so as not to exceed 150 words. Correction is required. See MPEP § 608.01(b).
2. The incorporation of essential material in the specification by reference to a patent application is objected to by the examiner. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. It is requested that the patent applications incorporated by reference be included in the application file, since some of those files are unavailable to the examiner for performing a thorough and complete examination. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).
3. Since the application is filed as a continuation in part, it is requested that the applicants identify the new matter added from the parent application.

Art Unit: 3622

Information Disclosure Statement

4. Examiner objects to the tremendous volume of references because more than 45 references, totaling more than 1,000 pages, were submitted. In order for the examiner to properly determine patentability over the prior art submitted, it is requested that the patent owner explain the significance of each reference or highlight those documents which have been specifically brought to patent owner's attention and/or are known to be of most significance. It is desirable to avoid the submission of long lists of documents. Examiner requests elimination of clearly irrelevant and marginally pertinent cumulative information. See *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), *aff'd*, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), *cert. denied*, 414 U.S. 874 (1974). But cf. *Molins PLC v. Textron Inc.*, 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 30-75 are rejected under 35 U.S.C. 101 because the claimed method does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998). Those independently claimed steps are abstract ideas which can be performed

Art Unit: 3622

without interaction of a physical structure. The independently claimed steps of collecting and processing information, receiving and retrieving a profile for correlating, and databases and servers not actively embodied in the claimed invention do not require structural interaction or mechanical intervention such that the invention falls within the technological arts permitting statutory protection. Also claims 38, 52, and 59-65 contain claimed pure algorithmic equations that do not require structural interaction or mechanical intervention such that the invention falls within the technological arts. The data associated with the pure algorithmic equations is considered non-functional descriptive material which will be discussed infra under the obviousness rejection. Because the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention, it does not produce a useful, concrete and tangible result, is not permitted under 35 USC 101 as being related to non-statutory subject matter. Furthermore each of the claimed steps can be performed by a human which further illustrate that the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention. The dependently claimed invention is also rejected since those claims are dependent upon what is considered non-statutorily permitted subject matter. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are statutorily permitted.

Art Unit: 3622

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 30-75 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, the independently claimed method and system including the steps of collecting and processing information, receiving and retrieving a profile for correlating, and databases and servers not actively embodied in the claimed invention site is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independently claim recitations “collecting,” “processing,” “receiving,” “retrieving,” and “correlating” are considered non-enabling because the specification does not provide a concrete example of those features. The specification recites this claimed concept but does not enable how those independently claimed method and system steps are enabled, such that one skilled in the art would know how to make and/or use the invention. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are reasonably conveyed to those skilled in the art.

Art Unit: 3622

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 30-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed method including the steps of collecting and processing information, receiving and retrieving a profile for correlating, and databases and servers not actively embodied in the claimed invention fail to particularly point out and distinctly claim the subject matter which applicant because those steps are considered indefinite from the accepted definitions to those skilled in the art and it is unclear that the specification provides adequate antecedent basis for those steps of how those claimed steps definite. The independently claimed recitations "collecting," "processing," "receiving," "retrieving," and "correlating" are considered indefinite because that subject lacks a modifier. It is also unclear of the vectors being correlated in claim 70 because the claim is interpreted to be self correlating of vectors. Some of the claims are also rejected for introducing terms without a proper antecedent basis from within the claim or its depending claim. These terms include "the subscriber characterization vector," "the advertisement," and "the applicable subscribers" (claim 70). However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are not indefinite.

Art Unit: 3622

11. The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

12. Claims 73-75 are rejected under 35 U.S.C. 112, sixth paragraph, as not setting a limit on how broadly the Office may construe means-plus-function language under the rubric of reasonable interpretation (please see MPEP 2181). The independently claimed secure correlation server is not construed means-plus-function language under the rubric of reasonable interpretation, because the specification does not provide a clear limit of patentability. The steps following the means recitation are merely exemplified after the “for” recitation and may incorporate any function that could be taught in the prior art. Since each of the independent claims contain the means-plus-function language, all claims dependent upon those claims are also rejected. In order to consider that claim in light of the prior art, examiner will assume that those claims contain a clear limitation under the broadest reasonable interpretation.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 3622

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

14. Claims 30-75 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hoarty et al. (US 5,319,455), Graves et al. (US 5,410,344), Wilkins (US 5,446,919), Saxe (5,636,346), Heckerman et al. (US 5,704,017), or Dedrick (US 5,724,521), and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hite et al. (US 5,774,170), Merriman et al. (US 5,948,061), Herz et al. (US 6,020,883 or US 6,088,722), or Lazarus et al. (US 6,134,532).

15. Claims 30-75 rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. An internet search shows the assignee, Expanse Networks, has had public use of the claimed invention for more than one year prior to filing of the present application because the

Art Unit: 3622

assignee web site lists steps of the claimed invention being performed as early as 1998 which is more than one year to the filing of the present application.

16. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: collecting subscriber information from sources, processing the information to generate a characterization vector, and correlating the information using databases and servers. Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 3622

19. Claims 30-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of a subscriber profiling information integration including privacy protected target advertising using secure correlation offered by Juno Online Services (hereinafter Juno). Since at least 1997, the Juno has performed the claimed method and system comprising:

- collecting information about a subscriber from one or more sources; and
- processing the information to generate a subscriber characterization vector; or
- receiving an advertisement profile for a particular advertisement;
- retrieving a subscriber profile for a particular subscriber; and
- correlating the advertisement profile and the subscriber profile to determine if the advertisement is likely to be of interest to the subscriber; or
- one or more distributed databases storing information about subscribers;
- a secure correlation server couple to the one or more distributed databases for retrieving the information from the one or more distributed databases; and
- generating subscriber characterization vectors based on the retrieved information; or
- a secure profiling system made up of one or more databases wherein the one or more databases store profile information about a subscriber;
- one or more advertisement sources for providing advertisements and advertisement characterization vectors defining a target audience of the advertisements;

Art Unit: 3622

a secure correlation server couple to the secure profiling system and the one or more advertisement sources for receding an advertisement characterization vector from one of the one or more advertisement sources;

retrieving profile information from the secure profiling system;

generating subscriber characterization vectors based on the retrieved profile information;

correlating the subscriber characterization vectors and the subscriber characterization vector;

selecting appropriate subscribers to receive the advertisement associated with the advertisement characterization vector; and

an access network for delivering the advertisement to the applicable subscribers; or

means for receding advertisement characterization vectors;

means for retrieving subscriber characterization vectors from one or more distributed databases; and

20. means for correlating the advertisement characterization vectors and the subscriber characterization vectors. Examiner also has personal experience of the claimed raw transaction data, television viewing, purchase transaction, or internet surfing data, ket and bra vectors, similar traits or demographic data, and weighted housing or socio-economic factors. The claimed collecting information about a subscriber from one or more sources and processing the information to generate a subscriber characterization vector is considered equivalent to examiner's experience of applying for a free Juno e-mail account and checking information

Art Unit: 3622

boxes such that appropriate advertisement data would be transmitted the examiner's new e-mail account. The claimed receiving an advertisement profile for a particular advertisement, retrieving a subscriber profile for a particular subscriber, and correlating the advertisement profile and the subscriber profile to determine if the advertisement is likely to be of interest to the subscriber is considered equivalent to examiner's experience of applying for a free Juno e-mail account and checking information boxes such that appropriate advertisement data would be transmitted the examiner's new e-mail account. The claimed one or more distributed databases storing information about subscribers, secure correlation server couple to the one or more distributed databases for retrieving the information from the one or more distributed databases, and generating subscriber characterization vectors based on the retrieved information is considered equivalent to examiner's experience of applying for a free Juno e-mail account and checking information boxes such that appropriate advertisement data would be transmitted the examiner's new e-mail account. The claimed secure profiling system made up of one or more databases wherein the one or more databases store profile information about a subscriber, one or more advertisement sources for providing advertisements and advertisement characterization vectors defining a target audience of the advertisements, secure correlation server couple to the secure profiling system and the one or more advertisement sources for receding an advertisement characterization vector from one of the one or more advertisement sources, retrieving profile information from the secure profiling system, generating subscriber characterization vectors based on the retrieved profile information, correlating the subscriber characterization vectors and

Art Unit: 3622

the subscriber characterization vector, selecting appropriate subscribers to receive the advertisement associated with the advertisement characterization vector, and access network for delivering the advertisement to the applicable subscribers is considered equivalent to examiner's experience of applying for a free Juno e-mail account and checking information boxes such that appropriate advertisement data would be transmitted the examiner's new e-mail account. The claimed steps including raw transaction data, television viewing, purchase transaction, or internet surfing data, ket and bra vectors, similar traits or demographic data, and weighted housing or socio-economic factors are equivalent to the routine steps involved in marketing and target advertising used by those skilled in the art such that it would be an obvious variation to apply those steps to the services offered by Juno. The claimed invention, recited by the applicant, has been provided by Juno long before the filing of applicants' invention. The only feature not expressly taught from examiner's personal experience is the claimed specific ket vector formulas. Examiner takes Official notice that it is old and well known to those skilled in the art of subscriber profiling information integration including privacy protected target advertising using secure correlation, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the expressed teachings of the examiner's experience. Furthermore examiner experience teaches the claimed invention except for the claimed automated features of database and server applications such that the claimed invention is considered merely an automated feature of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the

Art Unit: 3622

court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. Finally, the data associated with the pure algorithmic equations is considered non-functional descriptive material. Examiner's personal experience does not expressly show the data associated with the pure algorithmic equations is considered non-functional descriptive material. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The data associated with the pure algorithmic equations steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to collect and process profiles having any type of content, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. The motivation to combine applicants claimed invention with the services offered by Juno is to allow advertisers greater consumer targeting capabilities through electronic mediums, while transferring electronic information, which clearly shows the obviousness of the claimed invention.

Art Unit: 3622

Double Patenting

21. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

22. Claims 30-75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,216,129, or over claims 1-31 of U.S. Patent No. 6,298,348, or over claims 1-48 of U.S. Patent 6,324,519.

Although the conflicting claims are not identical, they are not patentably distinct from each other

Art Unit: 3622


because each of those patents receives and retrieves data in the same manner, using obvious variation terminology, to achieve the same result.

23. Claims 30-75 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 51-53, 80, 82-92, 94-113, and 115 of copending Application No. 09/452,893, or over claims 1-56 of copending Application No 09/731,606, or over claims 1-24 of copending Application No 09/824,434, or over claims 1-68 of copending Application No 10/229,783. Although the conflicting claims are not identical, they are not patentably distinct from each other because each of those patents receives and retrieves data in the same manner, using obvious variation terminology, to achieve the same result. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

24. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9326
Non-Official/Draft	(703) 872-9325


STEPHEN GRAVINI
PRIMARY EXAMINER

smg
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